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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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11/14/2005

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EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,212

Applicant(s)

LIU ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. The amendment to claim 3 has overcome the restriction thereof and claim 3 has been examined herewith.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haman et al. in view of Brox et al. (6,589,536) and Stolz (6,530,962). Regarding claim 2, attention is directed to the basis for rejection set forth in the Office Action mailed April 29, 2005. Regarding the amendment to claim 2, Haman lacks the teaching for the gelatin-based shell to include PEG, starch and an edible dye. Brox discloses a manufacturing method for soft gelatin capsules wherein the shell of the soft gelatin capsule includes PEG. Note claim 1 of Brox. It would have been obvious to one of ordinary skill in the art to include PEG in the shell of Haman for the reasons advanced by Brox and to take advantage of PEG's well known physical characteristics.

The combination of Haman in view of Brox also lacks the teaching for the shell to comprise a starch and a dye. Stolz provides a paint ball construction including a shell that may comprise starches and pigments (dyes). Note column 5, lines 51-61. It would have been obvious to one of ordinary skill in the art to include starches and dyes in the shell of Haman for the reasons advanced by Haman and also to take advantage of those materials' well known physical characteristics.

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Regarding the percentages of materials, the applicant has failed to demonstrate the criticality of these particular ranges by a new and unexpected result obtained therefrom and it appears that these ranges would be found by simple and routine experimentation.

Regarding claim 3, note column 2, lines 23-30 of Haman which teach a diameter of 4-7 mm.

Regarding claims 4 and 5, note the basis for these rejections set forth in the Office Action mailed April 29, 2005.

Regarding claims 6, 8 and 9, note claim 2 defining a molecular weight of 200 to 600.

Regarding claim 7, it would have been obvious to one of ordinary skill in the art to provide more than one type of PEG in order to customize the particular physical characteristics of the shell.

Regarding claim 10, note the basis for the rejection of claim 1.

Regarding claims 11-14, note the basis for the rejection of claim 1. Further, the recited dry weight ratio is considered to be obvious to one of ordinary skill in the art lacking a showing of the criticality of the recited ration by a new and unexpected result obtained therefrom.

Response to Arguments

4. Applicant's arguments filed August 29, 2005 have been fully considered but they are not persuasive. The applicant argues that contrary to the disclosure of Haman, he does not provide a seamless paintball. The applicant argues that the patents cited by Haman and incorporated by reference do not teach a seamless paintball. However, these arguments are not persuasive. Haman is explicit in stating that his paintball is seamless. Note column 2, lines 45-49. The applicant's argument that the patents incorporated by reference necessarily teach a seamed

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paintball is not persuasive as such arguments do not refute the positive recitation by Haman that his paintball is seamless.

The applicant also argues that there is no indication in the disclosure of Haman for a “truly seamless capsule”. This argument appears to be based on the method of manufacture of the capsule of the instant invention in comparison to the method of manufacture disclosed by Haman. While the capsule of Haman may not be to the same degree of a “truly seamless capsule” as argued by applicant, it is disclosed as a seamless capsule nonetheless. The applicant appears to be arguing a difference in degree between the seamless capsule of Haman and that of the instant invention, however, this degree is not brought out by the apparatus claims. Further, it would appear that this difference in degree is centered about the method of manufacture of the instant capsule as compared to the prior art. This is evidenced by applicant’s own arguments detailing the method of the manufacture set forth by the Patent to Scherer (2,318,718).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

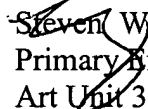
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
November 7, 2005